

REMARKS

Claims 1 to 53 and 55 are pending. Claim 54 was previously canceled.

Reconsideration of the application is requested.

§ 103 Rejections

Claims 1-3, 7-9, 22-24, 31-32, 35, 38, 40-42, and 47-50 are rejected under 35 USC § 103(a) as being unpatentable over Johnson et al. (US 5178924).

Claims 4-5, 43-44 and 55 are rejected under 35 USC § 103(a) as being unpatentable over Johnson et al. '924 in view of Reinders (US 6037028).

Claims 6, 10-21, 25-30, 33-34, 36-37, 39, 45-46 and 51-53 are rejected under 35 USC § 103(a) as being unpatentable over Johnson et al. '924 in view of Johnson et al. (US 5167995).

Each pending rejection relies on the following argument with respect to Johnson '924:

... since Johnson teaches that various copolymers can be used to form the release layer, including ethylene vinyl acetate, ethylene acrylic acid, etc. [col. 4, ll. 54-65], it would have been an obvious to one of ordinary skill in the art to substitute ethylene acrylic acid copolymer with the ethylene vinyl acetate, and mixing with a desired level of a tackifier for roll stability, because the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

(Final Office Action dated August 28, 2008; at page 3.)

In response to Applicants' previous arguments regarding the lack of a sufficient logical or legal basis for making this conclusion, the Examiner responded

Applicants argue at Remarks page 2 that "the mere fact that two materials are listed as alternatives for one purpose (e.g., as a release material) does not provide a logically or legally sufficient basis for concluding that those two materials are functionally equivalent for any other purpose (e.g., as a roll stability layer or as a friction enhancing agent)."

However, since Johnson '924 teaches modifying the release layer with tackifier (friction agent) to obtain improved roll stability, it is unseen that replacing the base copolymer of the release layer, exemplified ethylene acrylic acid copolymer, prevents surface property modifying effect of a tackifier (friction agent).

(Final Office Action dated August 28, 2008; Section 7, pages 5-6.)

Applicants' believe that both their position and the Examiner's position on this central issue have been well-developed. However, Applicants respectfully request further consideration of their previous arguments in light of the following additional comments made in response to the arguments set forth above.

First, the Patent Office stated "Johnson '924 teaches modifying the release layer with tackifier." However, this statement is too broad. Johnson '924 only teaches that ethylene/acrylic acid copolymers can be modified with a tackifier to form a friction enhancing agent. The Patent Office has failed to show where Johnson '924 describes, teaches or suggests that "release layers" in general can be modified with a tackifier to form a friction enhancing agent. That is, simply because one material that can be used a release agent can also be modified with a tackifier to form a friction enhancing agent does not mean that every material that can be used as a release agent can be modified with a tackifier to form a friction enhancing agent.

The Patent Office also stated "it is unseen that replacing the base copolymer of the release layer, exemplified ethylene acrylic acid copolymer, prevents surface property modifying effect of a tackifier (friction agent)." First, the proposed substitution is not "replacing the base copolymer of the release layer," it is replacing the base polymer of the separate and distinct friction enhancing agent located on the opposite side of the substrate from the release layer. Second, the Patent Office has failed to provide any basis for this attempt to separate the purported affect of the tackifier from that of the ethylene acrylic acid copolymer. Specifically, all that can be concluded from Johnson '924 is that "ethylene/acrylic acid mixtures containing tackifiers" are illustrative friction enhancing agents. The Patent Office has provided no support for the assertion that the tackifier alone provides some "surface property modifying affect." Nor has the Patent Office provided any basis for concluding that the tackifier alone is a "friction enhancing agent" that can be used independent of ethylene/acrylic acid mixtures to provide a friction enhancing agent.

In summary, Applicants maintain their position that the Patent Office has improperly combined the teachings of Johnson '924 regarding one suitable friction enhancing agent with the isolated and unrelated teachings of Johnson '924 describing various materials that may be used for an unrelated purpose, i.e., as a release layer. For at least these reasons, all pending rejections are improper and should be withdrawn.

Examination and reconsideration of the application is requested.

Respectfully submitted,

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